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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,540	08/31/2000	Carol Gruchala	8285/389	4775

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EXAMINER

NGUYEN, QUYNH H

ART UNIT PAPER NUMBER

2642

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,540

Applicant(s)

GRUCHALA, CAROL

Examiner

Quynh H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bannister et al. (U.S. Patent 5,668,862) in view of Swan et al. (U.S. Patent 5,978,451) and further in view of Cox (U.S. Patent 6,035,190).

Regarding claim 1, Bannister teaches a method of providing a telecommunication service comprising when a caller 14 dials the Personal Communication Service (PCS) subscriber's number, for example, a first destination is a home location 16, a second destination location at the first location is subscriber's cellular phone 17, and a third destination location at the second location is business location 15, etc. However, Bannister does not teach providing a menu in a telephone call, the menu providing a plurality of options; receiving a first selection of one of the destination options in the telephone call; routing the telephone call to a first telephone number corresponding to the first selection; after the routing the telephone call to the first telephone number, detecting an originating dual-tone multi-frequency (DTMF) trigger in the telephone call; interrupting the telephone call to the first telephone number; receiving a second

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selection of one of the destination options in the telephone call; and routing the telephone call to a second telephone number corresponding to the second selection.

Swan teaches providing a menu options to the caller, for example, "For adult press 1, for kids press 2"; receiving a selection of one of the destination options; routing the telephone call to the telephone number corresponding to the selection (col. 8, lines 17-24). However, Swan does not teach after the routing the telephone call to the first telephone number, detecting an originating dual-tone multi-frequency (DTMF) trigger in the telephone call; interrupting the telephone call to the first telephone number; receiving a second selection of one of the destination options in the telephone call; and routing the telephone call to a second telephone number corresponding to the second selection.

Cox teaches a method for monitoring the connection between the subscriber and the destination telephone. The subscriber who wishes directory assistance services is connected to an operator, the operator then initiates a call connecting the subscriber to the destination telephone number ("first telephone number"), detecting a DTMF signal issued by the subscriber such as "*" to interrupt the telephone call to the first telephone number, the subscriber is transferred back to the operator for further assistance, for example, routing the telephone call to a second telephone number (Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of providing a menu in a telephone call, the menu providing a plurality of options; receiving a first selection of one of the destination options in the telephone call; routing the telephone call to a first telephone

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number corresponding to the first selection, as taught by Swan; and after the routing the telephone call to the first telephone number, detecting an originating dual-tone multi-frequency (DTMF) trigger in the telephone call; interrupting the telephone call to the first telephone number; receiving a second selection of one of the destination options in the telephone call; and routing the telephone call to a second telephone number corresponding to the second selection, as taught by Cox, in Bannister's system in order to provide the caller controls over selecting his/her desired destination, and in the event of there is no answer from the first destination or the caller changes his/her mind after the first selection, the caller would have a chance to interrupt the telephone call to the first telephone number and select another destination without re-dialing the PCS number.

Regarding claims 2, 6, and 10, Bannister teaches the fourth destination for the first member of the family at a third location other than the residence, the first, and the second locations (Fig. 2A, "social club 204").

Regarding claims 3, 7, and 11, Bannister teaches the second destination option is for a mobile telephone (Fig. 2A, "cellular 201").

Regarding claims 4, 8, and 12, Bannister does not teach providing at least a portion of the menu in the telephone call after the detecting an originating DTMF trigger in the telephone call. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature mentioned above in Bannister's system in order to remind the caller list of destinations for another selection.

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Claim 5 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Bannister teaches a telephone network element having service logic ("service node 10") interacts with the host switch 11, voice mail 21, and application processor 22.

Claim 9 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Bannister teaches a computer readable medium having computer readable data (Fig. 1B, application processor 22 in service node 10).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 5, 6, 9, and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 6, and 14, 8, 12, and 13 and 16 of U.S. Patent No. 6,327,354. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application present the method, system and article for providing a family telecommunication service using and original dial-tone multi-frequency trigger. Claims

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1, 2, 5, 6, 9, and 10 of the instant application substantially corresponds to claims 1, 3, 6 and 14, 8, 12, and 13 and 16, respectively, of the of U.S. Patent No. 6,327,354. The common subject matter claimed above includes: A method, system and article for providing a family telecommunication service using and original dial-tone multi-frequency trigger. The difference between the instant application and the U.S. Patent is in the instant application in response to the DTMF trigger; receiving a second selection of one of the destination options in the telephone call and routing the telephone call to a second telephone number corresponding to the second selection. It would have been obvious to one of ordinary skill in the art that in the event of there is no answer from the first destination or the caller changes his/her mind after the first selection, the caller would have a chance to interrupt the telephone call to the first telephone number and select another destination without re-dialing the PCS number.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen
September 25, 2003


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
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